

## REMARKS

### 1. Formal Matters

#### a. Status of the Claims

Claims 34-37 are pending in this application. Claims 34 and 35 are allowed. Claims 36 and 37 are amended. Applicant respectfully requests entry of the amendments and remarks made herein into the file history of this application. Upon entry of these amendments, claims 36 and 37 will be pending and under active consideration.

#### b. Amendments to the Claims

Claims 36 and 37 are amended to clarify that the claimed vectors and probes, respectively, do not include any further sequence from the nucleic acid from which SEQ ID NO: 3588 is derived. Support for amended claims 36 and 37 can be found in the application as originally filed at paragraphs 24 and 28.

### 2. Patentability Remarks

#### a. 35 U.S.C § 102, Claim 37

On page 3 of the Office Action, the Examiner rejects claim 37 as allegedly being anticipated by Fodor et al. (US 2001/0053519 A1; "Fodor" hereafter). Claim 37 is directed to a claim including the 24 nucleotide-long sequence of SEQ ID NO: 3588 or its complement. Fodor allegedly teaches a nucleic acid of 25 nucleotides with each nucleotide being A, C, T (or U), or G. Such a nucleic acid would have over  $1.12 \times 10^{15}$  possible sequences. The Examiner asserts that the specific sequence of the claimed probe is somehow taught by the vast number of sequences that may possibly be derived from Fodor. Applicant respectfully disagrees.

The specific sequence of SEQ ID NO: 3588 is not disclosed in Fodor, nor is any sequence even remotely similar to SEQ ID NO: 3588. There is also no teaching or suggestion in Fodor to isolate or select the specific sequence of SEQ ID NO: 3588 from the  $1.12 \times 10^{15}$  sequence choices of Fodor. Therefore, the probe of instant claim 37 is not anticipated because one of skill could not at once envisage the claimed sequence from among the near endless number of possible sequences taught by Fodor. *See MPEP* § 2131.02, *citing Ex parte A*, 17 USPQ2d 1716 (Bd. Pat. App. & Inter. 1990) and *In re Petering*, 301 F.2d 676, 133 USPQ 275 (CCPA 1962). Accordingly, Applicant respectfully requests that the Examiner reconsider and withdraw the rejection of claim 37 under 35 U.S.C. § 102 over Fodor.

#### b. 35 U.S.C. § 103, Claim 36

On pages 3 and 4 of the Office Action, the Examiner rejects claim 36 as allegedly being unpatentable over Fodor. The Examiner asserts that it would have been obvious to make a vector comprising SEQ ID NO: 3588 because it was known to insert the probe allegedly taught by Fodor into a vector. As discussed above Fodor does not teach or suggest the specific sequence of SEQ ID NO: 3588,

or any remotely similar sequence from the  $1.12 \times 10^{15}$  possible sequences that could be generated from the 25-mer of Fodor. This fundamental defect of Fodor is not remedied by Fodor's alleged teaching to insert probe sequences into a vector. Accordingly, Fodor does not teach or suggest all the limitations of claim 36. In view of the foregoing remarks, Applicant respectfully requests that the Examiner reconsider and withdraw the rejection of claim 36 under 35 U.S.C. § 103 over Fodor.

### 3. Conclusion

Applicant respectfully submits that the instant application is in good and proper order for allowance and early notification to this effect is solicited. If, in the opinion of the Examiner, a telephone conference would expedite the prosecution of the instant application, the Examiner is encouraged to call the undersigned at the number listed below.

Respectfully submitted,

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